

REMARKS/ARGUMENTS

Applicant has received the Office Action dated November 26, 2010, in which the Examiner: rejected claims 1-9 under 35 U.S.C. § 101 as allegedly not failing within one of the four statutory categories of invention; 2) rejected claims 18-24 because the claimed invention is allegedly directed to non-statutory subject matter; and 3) rejected claims 1-27 under 35 U.S.C. § 102(b) as allegedly being anticipated by Kitamura (U.S. Pat. No. 7,236,526, hereinafter "Kitamura"). With this Response, Applicant amends claims 1, 8-10, and 18-25, and cancels claim 15. Based on the amendments and arguments contained herein, Applicant respectfully submits that this case is in condition for allowance.

I. THE § 101 REJECTIONS

Claim 1 has been amended to require each step to be performed by a "processing element" thereby tying the claimed method to a machine. The amendment is fully supported by the specification.

Regarding claim 18, the Examiner's interpretation is unreasonable because claims are to be construed in light of the specification, and Applicant's specification which says nothing of signals as being a type of computer-readable medium. At any rate, claim 18 has been amended to require a "memory unit" which finds support in the specification, and clearly avoids the claim as being reasonably interpreted as embodied in a signal.

Applicant believes all claims thus comply with § 101.

II. OVERVIEW OF KITAMURA

Kitamura addresses the problem of sequentially encoding and decoding a video file. Using a compression type of encoding technique leads to a degradation of the picture quality which is exacerbated with each subsequent decoding/encoding of the file. See cols 1-2. Kitamura addresses the problem by embedding in the video file being encoded encoding parameters that were previously generated and used to encode the file. Thus, the history of the encoding parameters generated for use by the various sequential encoders is

carried forward with the file. See col. 17, lines 44-59. When the file is to be encoded anew, the current encoder decides whether to use for the new encoding process the previously generated encoding parameters embedded in the video file, or whether to generate a new set of encoding parameters. See col. 21, lines 42-57.

Kitamura explains that, for an encoder, an operator specifies the type for each picture to be encoded by that encoder (I frame, P frame, B frame). The specification by the operator as to picture type is in the form of a GOP header. Col. 21, lines 14-23. Kitamura further explains that the determination by each encoder as to which encoding parameters to use is based on “whether or not the picture type of the reference picture determined from the GOP structure specified by the operator is the same as the picture type contained in the history information. That is, it determines whether or not the reference picture has ever been encoded into the picture type that is the same as the specified one.” Col. 21, lines 29-35.

III. THE CLAIM REJECTIONS

On a preliminary note, the Examiner appears to be misreading the claims. The claims require “a rule set” that comprise multiple rules. The Examiner refers repeatedly to multiple rule sets. Applicant’s claims do not require multiple rule sets.

Applicant’s claimed subject matter relates to a much different problem than that addressed by Kitamura. Applicant’s specification explains that incompatibility problems can prevent playback of encoded video files. For example, the DVD format requires a GOP header but the GOP header may be optional in an MPEG encoded file. Thus, burning an MPEG file to a DVD for playback by a DVD player may not work. Pages 6-7. Other incompatibility examples are identified as well in the specification. Such incompatibility problems are not at all the subject of Kitamura. Kitamura is only concerned with encoding a previously encoded file so as to minimize picture quality degradation. Applicant’s claims focus on the differences between Kitamura and Applicant’s contribution.

Claim 1, for example, requires comparing a portion of a file with a rule set that is not contained in the file itself. To the extent Kitamura teaches anything that could be remotely considered related to a rule set contained outside the audio/video file being evaluated, it would have to be operator-specified picture type as noted above. An operator specifies for an encoder the type of pictures to be encoded by that encoder. A picture type (I frame, P frame, etc.) is not a “rule set” and certainly not a rule set that comprises “an MPEG rule and a compatibility rule, said MPEG rule defining a format requirement for the file to be decoded by a first type of MPEG-capable decoder, and the compatibility rule defining a format requirement for the file to be decoded by a second type of MPEG-capable decoder.” A picture type is simply that, a type. A picture type would not reasonably be considered by one of ordinary skill in the art to be a rule or set of rules. At any rate, the Examiner has stated that Kitamura’s `sequence_header` and `group_of_picture` header are akin to the rules/rule sets. The headers to which the Examiner refers are contained in the file being evaluated, and thus do not match up to the rule set requirement that they are not contained in the file.

Claim 1 also has been amended to require that “as a result of determining that the file violates any of the MPEG and compatibility rules, performing, by the processing element, at least one of transcoding the file and alerting a user as to the violation.” Thus, either a user is alerted or the file is transcoded based upon a rule violation occurring. Transcoding is defined in the specification as decoding and then re-encoding the file. See para. 25. Kitamura has no teaching of alerting a user to the occurrence of a rule violation or transcoding the file based on the occurrence of a rule violation. Regarding dependent claim 9 which requires transcoding the file, the Examiner pointed to cols. 17, 20, and 21 in Kitamura but such passages simply refer to decoding and encoding of a file. Such transcoding is not described as being performed “as a result of determining that the file violates any of the MPEG and compatibility rules.”

For at least these reasons, claim 1 and its dependent claims are in condition for allowance.

Dependent claim 8 requires determining whether the portion of the file comprises a GOP header. The Examiner pointed to cols. 17, 20 and 21 of Kitamura which do refer to a GOP header, but not as being used in the method of claim 8. In claim 8, the transcoding the file or alerting the user occurs “upon determining that a GOP header is not present in the file.” In Kitamura, the decision as to whether to the transcode the file has nothing to do with the presence or absence of a GOP header. The GOP header may somehow factor in the transcoding process, but its presence or absence does not dictate whether transcoding is to occur.

Claim 10 has been amended to specify that the “application is configured to compare the file to the rules and to transcode the file based upon a determination that the file violates at least one of the rules.” As explained above, Kitamura transcodes files but the decision to do so has nothing to do with the whether a rule violation has occurred. For at least these reasons, claim 10 and its dependent claims are in condition for allowance. The same or similar reason applies to independent claims `8 and 25 and their dependent claims as well.

IV. CONCLUDING COMMENTS

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents

Appl. No. 10/753,251
Amdt. dated February 28, 2010
Reply to Office Action of November 26, 2010

accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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